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09/854,336	05/11/2001	Colin Hendrick	64482	7643

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EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/854,336

Applicant(s)

HENDRICK, COLIN

Examiner

Allyson N. Trail

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/1/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the Amendment filed January 21, 2005.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 8-11, 13, 18-21, 23, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Surloff et al (2002/0196227).

Surloff et al teaches the following in regards to claims 1, 11, 21, and 28:

“Embodiments of the present invention described below are directed to methods and apparatus for providing simplified access to the Internet, and for providing improved management of a user's Internet experience.” (Paragraph 0017).

Figure 1 illustrates a system 100. The system 100 includes a computer system 110 having a monitor 112, a CPU housing 114, a keyboard 116, a mouse 118 and a mouse pad 120. As shown in figure 1, the computer system may be coupled to the Internet through an Internet service provider (ISP) using one of a number of known Internet browser applications. The system 100 also includes

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web servers 122, 124 and 125 that are also coupled to the Internet and accessible by the computer system 110 over the Internet.” (Paragraph 0018).

“The electronics housing [of the mouse pad] includes a smart card interface device having a slot for receiving a smart card 130.” (Paragraph 0025).

“A secure mode of operation can be established after the smart card 130, which is positioned in the slot defined on the electronics housing, is validated. Smart card 130 validation can be based on reading and validating a personal identifier, which can be stored on the smart card 130. The personal identifier can be associated with a predetermined user of the smart card 130.” (Paragraph 0026).

The smart card interface device may be implemented using one of a number of available devices that provide reading and writing capabilities to memories contained on a smart card. In other embodiments, the smart card device may be a read-only device. (Paragraph 0029).

“The operation proceeds to step 216, wherein the minibrowser determines whether there is a smart card present in the mouse pad. If a smart card is present, then in step 218, the number for the smart card is read and provided to the minibrowser, and then the initial operation of the minibrowser proceeds to step 220.” (Paragraph 0044).

“The use of the smart card with the mouse pad 120 and computer system 110 in embodiments of the present invention provides a number of advantages and simplifies access to the Internet and simplifies the e-commerce process. A user of the computer system 110 may access the Internet by first placing the

user's smart card in the slot 28 of the mouse pad. The system is then able to identify the user based on information stored in the smart card." (Paragraph 0068).

"Once the user is authenticated, the user may press one of the previously described buttons on the mouse pad to access the Internet and purchase goods and services. In some embodiments, the content of the display (including advertisements) provided by the portal to the user, as well as the programming of the buttons on the mouse pad, may be tailored to the user based on information stored in the smart card." (Paragraph 0069).

"The information on the smart card may also include demographical data that can be used by web sites accessed by the user to tailor advertisements to the user and to allow the web sites to establish demographic profiles and trends of each user." (Paragraph 0069).

"Also, the smart card may be used in conjunction with the computer system 110 to store promotional material such as coupons, discounts or even gift certificates that may be downloaded from Internet sites and stored in the smart card. These coupons and gift certificates may be used by the user when accessing e-commerce sites through the computer system 110 or may be used by the user at traditional retail outlets that are equipped with smart card readers." (Paragraph 0070).

Surloff et al teaches the following in regards to claims 3, 13, and 23:

"In some embodiments, the system prompts the user to enter a personal identification number (PIN) before enabling all of the features of the smart pad."  
(Paragraph 0068).

Surloff et al teaches the following in regards to claims 8-10 and 18-20:

The user's shipping and credit card information may be stored in the smart card. The smart card is used to purchase products or services from various websites. The smart card therefore is able to track purchases made by the owner of the smart card. Additionally, because the smart card contains credit card information, an account balance for payment of products or services is stored on the card. Lastly, purchase information for each item bought may be stored on the smart card. That information is equivalent to the profit information for the owner of the digital content. (Paragraph 0065).

In the teachings above, it is evident that when the user is authenticated (via confirmation with the information stored on the smart card), he or she gains access the Internet and may purchase goods and services. In this respect the goods and services are digital content and the rights to the content is managed based on the authentication of the use.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 2, 4-7, 12, 14-17, 22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surloff et al (2002/0196227) in view of Miron (6,401,239).

Surloff et al's teachings are discussed above. In regards to claims 6, 16, and 26, see Surloff et al's teachings of 3, 13, and 23. Suloff et al however fail to specifically teach the digital content being in the form of software. Surloff et al additionally fail to teach the personal identification including a user name.

Miron teaches the following in regards to claims 2, 5, 7, 12, 15, 17, 22, 25, and 27:

"The present invention relates to downloading of electronic files from the Internet or other communication channels." (Col. 1, lines 5-6).

"Approximately 80% of all files transferred over the Internet are updated versions of previous files, for example, software updates, customer and supplier details, informational and statistical databases, books, manuals, encyclopedias, and more." (Col. 1, lines 20-24).

It would be beneficial to have a system for sending products and interactive marketing material in a non-disruptive manner to targeted users who have expressed an interest in receiving them without the suppliers of the products and marketing material requiring a database of targeted users." (Col. 2, lines 21-26).

"One of the aspects of downloading ties is download for authorized clients only. For example, in an Internet software shop where the user selects software to download, the user is directed to a payment details form for providing account

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details such as a password or credit card details. Once the account details have been verified the user may download the software. If the account details are not verified, then the software may not be downloaded.” (Col. 2, lines 27-34).

Miron teaches the following in regards to claims 4, 14, and 24:

“Moreover, in accordance with a preferred embodiment of the present invention, the client has a client identifier and the token is based upon the client identifier.” (Col. 4, lines 33-35).

Figure 8 shows the method of downloading digital content. The method includes providing account information, which may include a password, which may be interpreted as a user name.

In view of Miron's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Surloff et al's method of managing digital rights as disclosed above with Miron's teachings of managing rights to download specific products such as software. As discussed earlier, Surloff et al method manages user's access to websites for purchasing products or services. It is clear that software is a product, which may be purchased. Additionally, Surloff et al teaches above accessing client information from the smart card, therefore it would have been obvious to one of ordinary skill in the art to additionally require the user's name to be entered for verification as taught by Miron. One would be motivated to include the user's name for additional security.



***Response to Arguments***

6. Applicant's arguments, see pages 1-21, filed January 21, 2005, with respect to the rejection(s) of claim(s) 1-28 under McNabb et al have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Surloff et al and Surloff et al in combination with Miron. Surloff et al clearly teaches managing digital rights of digital content over a network. The digital content includes products purchases or coupons downloaded. Miron specifically teaches downloading software when access to the software is granted.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: DeMello et al (2005/0060266).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[allyson.trail@uspto.gov](mailto:allyson.trail@uspto.gov)].

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*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Allyson N. Trail  
Patent Examiner  
Art Unit 2876  
April 8, 2005

*Jared J. Furman*  
**JARED J. FURMAN**  
**PRIMARY EXAMINER**